REMARKS

Claims 1, 3 - 6, 8, 9 and 11 - 18 are pending in the present application. Applicants note with appreciation the allowance of claim 16. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are in condition for allowance.

Claims 1, 3-6, 9, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,213,957 to Milliman et al. Applicants respectfully disagree. Claim 1 reads as follows:

A biopsy system comprising:

a first placeholder element insertable through tissue to a first selected location in a patient's body, the first placeholder element including a first lumen extending therethrough to a distal opening which, when the first placeholder element is in the first selected location is adjacent to target tissue;

a handle including a channel extending therethrough for receiving the first placeholder element, the channel directing elements inserted thereinto to the first lumen, the handle being removably coupled to the first placeholder element so that the first place holder element may be left in the first selected location;

a tissue sampling element insertable to the first selected location via the first lumen for obtaining a sample of tissue from the first selected location, the tissue sampling element being removable from the first lumen while leaving the first placeholder element at the first selected location; and

a tissue treatment element insertable to the first selected location via the first lumen.

The Examiner argues that half housing sections 518a, 518b of Milliman meet the recited handle. In making this argument, the Examiner asserts that the sections 518a, 518b are "able to disconnect from a placeholder element 603 so that the element 603 may be left in the first selected location." Office Action at page 2. The "first selected location," according to claim 1, is "in a patient's body."

The element 603 that the Examiner likens to the recited placeholder element is actually the distal end 603 of a biopsy tissue marker 601. The tissue marker 601 extends from the distal end 603 to a proximal end that extends proximally from the proximal the end of housing halves 518a, 518b (collectively referred to as blunt obdurator 518). As shown in Figure 44, a mounting tube 585 has its distal end joined to the proximal end of the blunt obdurator 518; the proximal end of a mounting tube 585 receives the tissue marker 601. The tissue marker 601 is inserted through mounting tube and through the blunt obdurator 518 until the distal end 603 of the tissue marker 601 emerges from the distal aperture of the blunt obdurator 518.

A structurally significant aspect of the tissue marker 601 is the block-shaped element that abuts against the proximal end of the mounting tube 585. This block-shaped element is located distally of the disk shaped element of the tissue marker 601. The significance of the block-shaped element is that it prevents the tissue marker 601 from being left in the first selected location in the patient. As stated above, the Examiner believes that the distal end 603 of the marker 603 can be left inside a patient after being decoupled from the blunt obdurator 518. Since the distal end 603 belongs to the marker 601, in order to leave the distal end 603 inside a patient, the entire marker 601 must be decoupled from the blunt obdurator 518. If the distal end 603 has been located inside a patient, then it can be left behind only by the sliding blunt obdurator 518 in a proximal direction relative to the marker 601. Nevertheless, this proximal sliding cannot be accomplished because, as described above, such a motion would be prevented by the abutment of the mounting tube 585 against the block-shaped element of marker the 601. Since blunt obdurator 518 cannot be slid proximally with respect to the marker 601, the distal end 603 of the marker 601 cannot be left inside a patient because the blunt obdurator 518 cannot be decoupled from the marker 601 while leaving its distal end 603 inside the patient. Therefore, it is not the case that Milliman identically teaches "the handle being removably coupled to the first placeholder element so that the first place holder element may be left in the first selected location."

Milliman also does not identically teach the recited "tissue sampling element insertable to the first selected location via the first lumen." In addressing this limitation, the Examiner states "where a tissue sampling element occurs at the tip of element 603 is capable of obtaining a sample of tissue...." Office Action at page 2. It is not clear whether the Examiner considers the tissue sampling element to be met by the tip 603, or by an unidentified element that can be inserted through the tip 603. If the Examiner meant the former, then that would be an incoherent position because the claim recites the tissue sampling element as being insertable via the lumen of the placeholder element. Since the Examiner identifies the distal tip 603 as the recited placeholder element, the distal tip 603 cannot also serve as the tissue sampling element because the distal tip 603 cannot be insertable through itself. Such a position is logically incoherent. On the other hand, if the Examiner meant the latter alternative, that argument fails for lack of evidence, since there is no element, certainly none specifically identified by reference character by the Examiner, that is inserted through the distal end 603 in order to sample tissue.

Another element recited in claim 1 is "a tissue treatment element insertable to the first selected location." The Examiner does not address this element. Therefore, the Examiner has not met his burden of establishing that Milliman identically teaches every limitation in the claim. In view of this discussion, withdrawal of this rejection is requested.

Claims 8, 11, 12, 15, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Milliman in view of U.S. Patent No. 6,497,706 to Burbank. Since Burbank does not overcome the deficiencies noted above with respect to Milliman, withdrawal of this rejection is requested.

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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